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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                    | CONFIRMATION NO. |
|--|-------------|----------------------|--|------------------|
| 09/921,238   | 08/02/2001  | Benjamin Mosier      | 0468FV.044178                          | 9707             |
| 35979  | 7590        | 08/29/2006           |  |                  |
| BRACEWELL & GIULIANI LLP<br>P.O. BOX 61389<br>HOUSTON, TX 77208-1389 |             |                      |  |                  |
|  |             |                      | EXAMINER<br>VIJAYAKUMAR, KALLAMBELLA M |                  |
|  |             |                      | ART UNIT<br>1751                       | PAPER NUMBER     |

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                     |                               |  |
|------------------------------|-------------------------------------|-------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/921,238       | Applicant(s)<br>MOSIER ET AL. |  |
|                              | Examiner<br>Kallambella Vijayakumar | Art Unit<br>1751              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 58-64,72,77,80,82,86,94-106 and 108-110 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4-5, 11-13, 16, 19-23, 25, 32-33, 38, 40, 44, 46, 48 and 114 is/are rejected.
- 7) ☒ Claim(s) 34-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims pending in the application are 2,4,5,11-13,16,19-23,25,32-38,40,44,46-48,58-64,72,77,80,82,86,94-106,108-110 and 114.

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**DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/21/2006 has been entered.

Claims 2, 4-5, 11-13, 16, 19-23, 25, 32-38, 40, 44, 46-48, 58-64, 72, 77, 80, 82, 86, 94-106, 108-110 and 114 are currently pending with the application. Claims 2, 19, 23, 25, 38, 46, 48 and 114 were amended. Claims 58-64, 72, 77, 80, 82, 86, 94-106 and 108-110 are withdrawn from further consideration as being non-elected invention in response to the restriction requirement in office action mailed 03/25/2004. The status of claims 86 and 108 should read as currently amended. Claim-90 was cancelled in amendment filed 08/15/2003 and its status is missing.

***Response to Arguments***

Applicant's arguments with respect to claims filed 7/21/2006 have been considered but are moot in view of the new ground(s) of rejection.

***Response to Amendment***

The amendment to the claims and the declaration of Fred Massey under 37 CFR 1.132 filed 7/21/2006 is sufficient to overcome the rejection of claims based upon Sturwold et al (US 4,067,817).

***Claim Rejections - 35 USC § 102******Claim Rejections - 35 USC § 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 2, 4-5, 11-13, 16, 19-23, 25, 32-33, 38, 40, 44, 46, 48 and 114 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hutching et al (US 3,755,385).

Hutching et al teach the composition and a method of making lower alkyl esters of unsaturated and saturated fatty acids from natural fats and oils <glyceride/triglycerides> such as ricinoleic acid by transesterification with of oils/ricinoleic-acid with lower-alcohol/propanol in presence of a mineral acid

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catalyst such as  $\text{H}_3\text{PO}_4$ . The reaction mixture contained at least about three equivalents of lower-alcohol per equivalent of glyceride ester and 0.01-1.0 equivalent of mineral acid catalyst per equivalent of acid in the oil or fat. The transesterification was carried out at a temperature between 50-340F. The fatty acid esters were separated by solvent extraction with hydrocarbon solvents establishing their solubility in hydrocarbons (Abstract, C-3, Ln 14- C-4, Ln 35; C-4, Ln 61). The phosphorus-compound and the compositions set forth in the claims are anticipated because the prior art composition of reacting components, their ratios, and the process conditions are identical to that by the applicants (See Specification, Page-27) and identical processing of identical reactant composition will result in an identical product. The formation of glycerol and phosphorus compounds in the phosphoric acid catalyzed transesterification of ricinoleic triglycerides will be anticipated. The formation of dimer/trimer and estolides in the composition will be inherent due the process conditions and the presence of hydroxyl and carboxyl functions in the ricinoleic acid molecule, and the presence of phosphoric acid in the reaction medium (See Silverstone et al, US 3,661,956, C-1, Ln 26-36). If the product in the product-by-process claim is the same as the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). A short genus of propanol includes n-propanol and i-propanol. The solvent meets the limitation of miscibility enhancement additive/surfactant in claim-33. All the limitations of the instant claims are met.

The reference is anticipatory.

In the alternative that the disclosure be insufficient to arrive at the limitations of the instant claims, it would be obvious to a person of ordinary skilled in the art to optimize the reactants ratio and the process temperature in the making of fatty esters as choice of design of process conditions of manufacture with reasonable expectation of success, because the prior art is suggestive of it.

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***Allowable Subject Matter***

Claims 34-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record neither teaches nor fairly suggestive of adding a specific miscibility-enhancement-additive to the composition or its amount or further reacting the composition with a specific compound forming further-substituted fatty-acid ester.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 8.30-6.00 Mon-Thu, 8.30-5.00 Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571-272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KMV  
August 25, 2006.

  
DOUGLAS MCGINTY  
SUPERVISORY PATENT EXAMINER

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